

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Fumio SAKIYA

Group Art Unit: 3652

Application No.: 10/516,591

Examiner: J. RUDAWITZ

Filed: March 5, 2005

Docket No.: 121965

For: SHEET-LIKE ELECTRONIC COMPONENT CLEAN TRANSFER DEVICE AND
SHEET-LIKE ELECTRONIC COMPONENT MANUFACTURING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal and Petition for Extension of Time is attached. Applicant respectfully requests review of the Final Rejection mailed September 7, 2007 in the above-identified application in light of the following remarks.

Claims 1-11 are pending in this application. This review is requested because Applicant believes that the rejection of at least dependent claim 4 under 35 U.S.C. §103(a) over JP-A-2000-357641 to Terou et al. (hereinafter "Terou") in view of U.S. Patent No. 5,507,847 to George et al. (hereinafter "George") and further in view of U.S. Patent No. 5,975,834 to Ogawa et al. (hereinafter "Ogawa") is in error for at least the following reasons.

Applicant filed an Amendment After Final Rejection ("AAFR") on December 28, 2007. In the AAFR, the claim amendments were limited to amending independent claim 1 to include the features of dependent claim 4, canceling claim 4, and amending claims 5, 7, 8 and 10 to correct informalities. On January 22, 2008, an Advisory Action was mailed that indicated the proposed amendments would not be entered because they were considered to

raise new issues requiring further consideration and/or search. The Advisory Action did not indicate the status of each claim on appeal or that the amendments would be entered for the purpose of appeal. Applicant's representative contacted Examiner Rudawitz to indicate that it was Applicant's intention to proceed to appeal. Applicant's representative requested that the Examiner indicate the status of the claim amendments for appeal, to include requesting that the Examiner issue a supplemental Advisory Action to provide this information. The Examiner refused Applicant's representative's request.

Applicant is particularly requesting that this Panel review the status of claim 4, by which the Applicant amended claim 1. Applicant believes that this combination of features should not have been considered to raise any new issue requiring further consideration and/or search. At least, entry and consideration and proper reply to Applicant's Remarks set forth in the December 31 AAFR, rather than simply summary dismissal of Applicant's arguments subject to filing a Request for Continued Examination, is believed warranted.

Claim 4 recites, among other features, a sheet-like electronic component clean transfer device that includes a conveying robot comprising a dust generation preventing seal structure provided to an articulated part of the arm, and a vent hole which downwardly discharges air in a body which supports the arm with a descending operation of the body. Terou, George and Ogawa cannot reasonably be considered to teach, or to have suggested, this combination of features for at least the following reasons.

The Office Action, on page 5, concedes that the combination of Terou and George fails to teach, or to have suggested, this combination of features. The Office Action relies on Ogawa to overcome this deficiency. In particular, the Office Action asserts, on page 5, that Ogawa additionally teaches the robot moving vertically. Therefore, the Office Action continues, as the robot moves either up or down, it is inherent that there is an air, or vent, hole

in the bottom, outside the clean room" (emphasis added). For the following reasons, Ogawa cannot reasonably be interpreted to support the assertions made in the Office Action.

First and contrary to the assertions made in the Office Action, Ogawa cannot reasonably be interpreted as teaching, or having suggested, a robot that moves vertically. As described for example in col. 8, line 62 - col. 9, line 3, Ogawa teaches a two-armed transfer robot having first and second handling members 24, 44 attached to respective arm mechanisms 23, 43. The handling members 24, 44 are vertically spaced from each other such that upon horizontal movement, the two handling members do not interfere with each other. Ogawa teaches that the handling members 24, 44 move both linearly and rotationally in a horizontal plane. Ogawa does not teach that the handling members 24, 44 move vertically.

Second, the Office Action, in an unsupportable conclusory manner, asserts that Ogawa inherently teaches a vent hole outside a clean room. This assertion, even if true, fails to map features disclosed in Ogawa to the subject matter of the pending claims. As described in Applicants' specification on page 8, line 11 - page 9, line 5, air is downwardly discharged from a vent hole of the body on a lower side of the first floor, and then discharged to an outside of the casing. Thus, even if Owaga inherently teaches a vent hole outside a clean room, as asserted in the Office Action, Owaga would not teach a vent hole having all of the combinations of features positively recited in the claims.

Third, the Office Action fails to apply a proper standard by which to assert what Owaga may inherently teach. To establish inherency, the Office Action must provide evidence or technical reasoning that makes it clear that the missing descriptive matter "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art." Inherency may not be established by "probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *See* MPEP §2112; *In re Robertson*, 169 F3d 743, 745 (Fed. Cir. 1999).

The standard requires that a basis in fact and/or technical reasoning to show that "the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *See* MPEP §2112. The Office Action fails to show that the allegedly inherent characteristic necessarily flows from the teachings of Ogawa. As noted in the Field of the Invention section of Owaga, the Owaga disclosure is directed to a two-armed transfer robot for transferring workpieces between processing chambers under a vacuum. For at least the reasons described above, and additionally because the processing chambers of Owaga are operated under a vacuum, Owaga cannot reasonably be interpreted as teaching, or having suggested, an inherent characteristic of a vent hole from which air is downwardly discharged upon a descending operation of the body.

Rapisarda is not applied in any meaningful way to the subject matter of claim 4 that would overcome the above-identified shortfalls in the application of the combination of Terou, George and Owaga to the combination of all of the features positively recited in that claim. As such, any permissible combination of Terou, George, Owaga and even Rapisarda would not have reasonably suggested the combination of all of the features positively recited in claim 4.

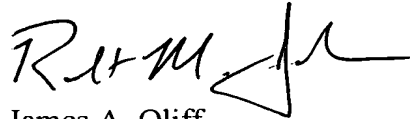
Accordingly, Applicant believes that the amendment of claim 1 to incorporate the subject matter of claim 4 as set forth in Applicant's December 31 AAFR should be entered and the combination of features recited in that claims, as amended, be determined to be patentable over any permissible combination of the applied references. Reconsideration and withdrawal of the rejections of the pending claims, as amended, are respectfully requested.

Applicant believes that upon review of the Final Rejection, based on the arguments presented above, that the Review Panel will find that the rejection of at least claim 4 over the asserted combination of applied references to be in error. Applicant, therefore, respectfully

submits that claim 4 is allowable. Favorable reconsideration and withdrawal of the rejection of claim 4 is earnestly solicited.

Should the Review Panel believe that anything further is desirable to place the application in even better condition for allowance, it is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Robert M. Jackson
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JAO:DAT/eks

Attachment:

Notice of Appeal and Petition for Extension of Time

Date: February 25, 2008

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